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OFFICE OF PETITIONS

In re Application of :
Sampson et al. :
Application No. 09/836,012 : ON PETITION
Filed: 17 April, 2001 :
Attorney Docket No. 10992153-1 :

This is a decision on the petition filed on 15 February, 2002 (certificate of mailing date 21 December, 2001), in response to the Notice of Incomplete Reply, requesting that the rules of practice be waived such that the Sequence Listing filed with the present petition on 15 February, 2002, be considered as timely filed. The petition is properly treated as a petition under 37 CFR 1.183 to excuse the delay in submission of the aforementioned document.

The petition is dismissed.

BACKGROUND

On 17 April, 2001, the above-identified application was filed. On 6 July, 2001, Initial Patent Examination Division (IPED) mailed a Notice to File Missing Parts of Nonprovisional Application requiring (a) an executed oath or declaration, (b) a surcharge for its late filing, and (c) compliance with the requirements of 37 CFR 1.821-1.825 regarding a Sequence Listing.

In response, on 24 September, 2001 (certificate of mailing date 17 September, 2001), applicants filed a one (1)-month time extension, accompanied by an executed Declaration and the late filing surcharge. Accordingly, on 19 October, 2001, IPED mailed a Notice of Incomplete Reply (Nonprovisional) requiring compliance with 37 CFR 1.821-1.825, in regards to the Sequence Listing. The Notice stated that the time period for reply remained as set forth in the Notice mailed on 6 July, 2001.

In response, on 15 February, 2002 (certificate of mailing date 21 December, 2001), petitioners the Computer Readable Format (CRF) of the Sequence Listing, an initial paper copy, an amendment directing its entry, and the statement under 37 CFR 1.821.

The present petition also accompanied the Sequence Listing. Petitioners assert additional time should have been granted to comply with 37 CFR 1.821-1.825 because the reply of 24 September, 2001, was a *bona fide* reply. Petitioners request that the reply filed on 15 February, 2002, be accepted as timely filed, or, alternatively, that a new time period for submission of the response be provided.

OPINION

Petitioners seek waiver of the rules on the grounds that the delay in complying with 37 CFR 1.821-1.825 was "*bona fide* and there was no intention to delay proceedings in this case." Petitioners also complain that the Notice of Incomplete Reply was not received until 14 December, 2001, nearly three (3) months after petitioners' response was filed.

37 CFR 1.135(c) states:

When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertantly omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Petitioner's contention that a new time period should be set is not well taken, however, because the Notice mailed on 6 July, 2001, clearly stated that the application did not comply with the requirements of 37 CFR 1.821-1.825. As such, petitioners' reply filed on 24 September, 2001, was not substantially a complete reply. Furthermore, 37 CFR 1.135(c) states that the Office may, but is not required, to set a new time period for reply.

Although the USPTO attempts to notify parties as to defective papers in order to permit timely refiling, it has no obligation

to do so.¹ Rather, it is the applicants who are ultimately responsible for filing proper documents.² That there was a considerable delay in advising applicants that the reply to the Notice to File Missing Parts was not fully satisfactory is regretted, but, as noted above, part of applicants' assumed risk. That is, the failure to supply the proper reply was the fault of petitioners, not the PTO. As noted in Brenner v. Ebbert, 398 F.2d. 762, 765, 157 USPQ 609, 611 (D.C. Cir. 1968), cert. den. 159 USPQ 799:

The Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received.

In essence, petitioners seek to avoid payment of the four (4) month extension of time to reply to the Notice mailed on 6 July, 2001, by way of requesting a belated time period under 37 CFR 1.183, so as to make the belated reply timely.

Suspension of the rules under 37 CFR 1.183 should be considered herein, suspension may be granted in an "extraordinary situation, when justice requires". The facts presented on the record do not establish an extraordinary situation. Petitioners have not established any special circumstances or equities that would require suspension of the rules in the interests of justice.

Here, as the statutes and regulations provide petitioners with the means for seeking acceptance of the delayed Sequence Listing abstract by way of extensions of time in accordance with 37 CFR 1.136(a), it is not necessary to also fashion an extraordinary remedy, even assuming such would constitute a proper exercise of the rules. Moreover, the PTO will not normally consider an extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought.³

Applicant was given reasonable notice as to the necessity to timely file a Sequence Listing in compliance with 37 CFR 1.821-1.825 in the Notice mailed on 6 July, 2001. It follows, as noted above, that petitioner had received the reasonable notice

¹See In re Colombo Inc., 33 USPQ2d 1530, 1532. (Comm'r Pat. 1994).

²Id.

³See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982).

required so as ensure a timely and full response. That petitioners failed to timely and adequately respond was unfortunate, but such failure did not operate to save this application from abandonment, nor was the failure to properly reply a circumstance beyond the control of petitioner in the exercise of reasonable care and diligence.⁴ As such, there is no adequate showing of "an extraordinary situation" in which "justice requires" suspension of the rules.⁵ Even assuming, *arguendo*, that clerical inadvertence or mistake led to petitioner's failure to submit a proper reply, such is not a grounds for requesting waiver of the regulations.⁶

Circumstances resulting from petitioners' failure to exercise due care, or lack of knowledge of, or failure to properly apply, the Patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief.⁷

The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of petitioner, and petitioner is bound by the consequences of those actions or inactions.⁸ Here, the problem at issue could also have been avoided by the exercise of ordinary care and diligence. Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence.⁹

As petitioners have not shown any extraordinary circumstance where justice requires waiver of the rule, the petition will be

⁴See Brenner, supra.

⁵See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers).

⁶See In re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994) (clerical error causing delay leading to a loss of right does not warrant suspension of the rules).

⁷See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

⁸Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987).

⁹U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983).

dismissed.

As authorized by the transmittal letter accompanying the present petition, counsel's deposit account, No. 50-1078, will be charged the petition fee of \$130.00 for the present petition and a four (4) month extension of the time to reply to the Notice mailed on 6 July, 2001 in the amount of \$1,440.00.

Further correspondence with respect to this matter should be addressed as follows:


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The application is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood at (703)308-6918.


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